



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,557	12/27/2001	Yoshiko Akazawa	1083.1084	9898

21171 7590 12/19/2006
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
----------	--------------

2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/026,557	AKAZAWA ET AL.	
	Examiner	Art Unit	
	Victor Lesniewski	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6 and 8-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/12/2006 has been placed of record in the file.
2. Claims 1, 2, 4, 8-13, and 15-18 have been amended.
3. The rejection of claims under 35 U.S.C. 112 is withdrawn in view of the amendment.
4. Claims 3, 5, and 7 have been canceled.
5. Claims 1, 2, 4, 6, and 8-18 are now pending.
6. The applicant's arguments with respect to claims 1, 2, 4, 6, and 8-18 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

Response to Amendment

7. Some claims have been amended to make clarifications in wording. Also, claims have been amended to incorporate the subject matter from the canceled claims into certain independent claims. However, none of the amended claims show a patentable distinction over the prior art of record. Since some claims have been amended, the rejection will be restated, taking into account the changes.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 10, 11, 17, and 18 remain rejected under 35 U.S.C. 101, as presented in the previous action dated 6/9/2006, because the claimed invention is directed to non-statutory subject matter. Concerning claims 10 and 11, the applicant's specification defines a computer

Art Unit: 2152

program in terms of both statutory and non-statutory embodiments. See the specification, page 25, lines 1-10. A claim that can be read so broadly as to include statutory and non-statutory subject matter must be amended to limit the claim to a practical application. Concerning claims 17 and 18, the applicant's specification does not distinguish between computer-readable storage and a "computer program" or a "computer memory product" and thus it is concluded that the definition in the specification of a computer program in terms of both statutory and non-statutory embodiments is also relevant to these claims.

10. Concerning the applicant's arguments that the rejection has no legal basis, the applicant is directed to MPEP 2106.01. It is noted that the specification is evidence that the applicant intended for the term to cover at least the examples disclosed. With the examples including something the Office does not consider to fall within a statutory category, the reasonable interpretation of the claim is that it is sufficiently broad to cover both statutory and non-statutory embodiments, and must be amended to be limited to statutory embodiments.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 8-12, and 15-18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Karaev et al. (U.S. Patent Number 5,802,518), hereinafter referred to as Karaev.

Art Unit: 2152

13. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system, a device, an apparatus, or a computer-readable medium are rejected under the same rationale applied to the described claim.

14. Karaev has disclosed:

- <Claims 1, 2, 8-12, 15, and 16>

An information providing method for providing provision information which is to be provided and registered in a central apparatus in response to a request from plural terminal devices which are connected to said central apparatus by a communication network, comprising the steps of: accepting, by one terminal device, as one set of data provision information, recipient information relating to a recipient who is authorized to receive said provision information, and a provision format of said provision information to be applied to said recipient (column 6, lines 21-43), the provision format including a portable document format which is converted from provision information and an original format which is not converted from provision information (column 3, lines 34-39); transmitting, by said one terminal device to said central apparatus, the one set of data after said accepting; registering, in said central apparatus, the one set of data after said transmitting (column 6, lines 21-43); receiving, by said central apparatus, a request and recipient information of a recipient who generated the request transmitted from one of terminal devices (column 11, lines 19-46); and providing, by said central apparatus to said one of terminal devices which transmitted the request and the recipient information, the provision information corresponding to the provision format based on the recipient

Art Unit: 2152

information registered in the one set of data (column 15, line 60 through column 16, line 7).

- <Claim 17>

A method for providing requested information to authorized recipients, comprising: storing, as one set of data in computer-readable storage accessible by at least one server, provision information stored in an original format and a portable document format converted from the provision information and accessible by authorized recipients, recipient information indicating what in the provision information each of the authorized recipients is authorized to receive, and format information corresponding to the provision information and the recipient information indicating in what format the provision information can be provided to each of the authorized recipients (column 6, lines 21-43 and portable document format at column 3, lines 34-39); receiving, by the at least one server from a requesting terminal device, a request for at least one item of the provision information and a recipient identifier (column 11, lines 19-46); and transmitting, from the at least one server towards the requesting terminal device, requested provision information in a registered provision format if the recipient information indicates that permission to access the requested provision information in the registered provision format has been granted to the recipient identifier (column 15, line 60 through column 16, line 7).

- <Claim 18>

A method as recited in claim 17, further comprising: receiving, by the at least one server from a providing terminal device, a provider name for a provider of new provision

Art Unit: 2152

information (column 6, lines 29-36); and accepting, by the at least one server for storage in the computer-readable storage if the provider name is authorized according to the recipient information, the new provision information, authorized recipient information identifying at least one recipient who is authorized to receive the new provision information, and at least one indication of an authorized format in which the new provision information is to be provided to the at least one recipient (column 6, lines 21-43), the authorized format including at least an original format of the new provision information and a portable document format converted from the new provision information (column 3, lines 34-39).

Since all the limitations of the invention as set forth in claims 1, 2, 8-12, and 15-18 were disclosed by Karaev, claims 1, 2, 8-12, and 15-18 are rejected.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaev, as applied above, in view of D'Angelo (U.S. Patent Number 6,717,938).

17. Karaev disclosed a system for the secure electronic distribution of documents over the world wide web. In an analogous art, D'Angelo disclosed a communications system that allows

Art Unit: 2152

users to control what elements of their personal information are available by other users via directory servers.

18. Concerning claims 4 and 13, Karaev did not explicitly state the accepting, transmitting, registering, or providing steps as including name disclosure information as claimed. However, D'Angelo's system allows a user to decide whether or not his name or other personal information is published on a server. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Karaev by adding the ability to include name disclosure information in the one set of data so that the accepting, transmitting, registering, and providing steps included the name disclosure information as provided by D'Angelo. Here the combination satisfies the need for an Internet information delivery system that provides information only to users who are authorized to receive it. See Karaev, column 3, lines 3-9. This rationale also applies to those dependent claims utilizing the same combination.

19. Thereby, the combination of Karaev and D'Angelo discloses:

- <Claims 4 and 13>

The information providing system as set forth in Claim 2, wherein said processor of said one terminal device is further capable of performing an operation of accepting, as part of the one set of data, name disclosure information indicating whether or not a name of provider who provides the provision information to be disclosed; said operation of transmitting further transmitting the name disclosure information as part of the one set of data; said operation of registering further registering the name disclosure information as part of the one set of data; and said operation of providing further providing to the one of said terminal devices which transmitted the request and the recipient information, a name

Art Unit: 2152

of provider based on the recipient information and the name disclosure information registered in the one set of data (D'Angelo, column 20, lines 3-13).

Since the combination of Karaev and D'Angelo discloses all of the above limitations, claims 4 and 13 are rejected.

20. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaev, as applied above, in view of Bhagwat et al. (U.S. Patent Number 6,563,517), hereinafter referred to as Bhagwat.

21. Karaev disclosed a system for the secure electronic distribution of documents over the world wide web. In an analogous art, Bhagwat disclosed methods for transcoding provision information that take into account varying network characteristics.

22. Concerning claims 6 and 14, Karaev did not explicitly state the registering, judging, or providing steps as including auxiliary provision information as claimed. However, Bhagwat's system creates auxiliary provision information to be used depending on the network or network characteristics. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Karaev by adding the ability to include auxiliary provision information in the one set of data so that the registering, judging, and providing steps included the auxiliary provision information as provided by Bhagwat. Here the combination satisfies the need for an Internet information delivery system that provides information only to users who are authorized to receive it. See Karaev, column 3, lines 3-9. This rationale also applies to those dependent claims utilizing the same combination.

23. Thereby, the combination of Karaev and Bhagwat discloses:

Art Unit: 2152

- <Claims 6 and 14>

The information providing system as set forth in Claim 2, wherein said operation of registering further registering, as part of the one set of data, auxiliary provision information whose information volume is reduced from said transmitted provision information; said processor of said central apparatus is further capable of performing an operation of judging whether a request from the one of said terminal devices is transmitted through said network or through another network different from said network; and said operation of providing further providing auxiliary provision information, according to the provision format registered in the one set of data, to the one of said terminal devices based on the recipient information registered in the one set of data when it is judged that the one of said terminal devices transmits the request through the other network (Bhagwat, column 5, lines 12-50).

Since the combination of Karaev and Bhagwat discloses all of the above limitations, claims 6 and 14 are rejected.

Response to Arguments

24. In the remarks, the applicant has argued:

- <Argument 1>

Karaev does not disclose the features of claim 1 because he does not disclose “the provision format including a portable document format which is converted from provision information and an original format which is not converted from provision information” as recited in claim 1.

- <Argument 2>

Karaev does not disclose the features of claim 1 because he does not disclose accepting “a provision format of said provision information to be applied to said recipient” as recited in claim 1.

25. In response to argument 1, Karaev does disclose the formats as recited in claim 1. The previous line citation, column 3, line 34-39, shows the ability of the system to convert files into PDF format. The files also have an original format. By virtue of “conversion” the original format must be different, otherwise there would be no need to convert. The files can be maintained in an original format or in an alternative format, like PDF.

26. In response to argument 2, Karaev does disclose the accepting step as recited in claim 1. The previous line citation, column 6, lines 21-43, shows the acceptance of report information by contribution servers and a central site. Concerning the provision format, Karaev’s system utilizes a document profile (report information) to determine the format for the file. See also, column 1, lines 38-47 and column 4, lines 55-63.

27. Concerning the applicant’s arguments that the claims are distinguished over Karaev because Karaev does not teach that anyone other than an administrator has control over the format into which files are converted and because Karaev does not teach that either the contributor or a recipient can specify the format, it is noted that user specification or control of the format is not a limitation of the claim. The claim simply states accepting a provision format (which Karaev teaches in that his system maintains files in a format to be applied to recipients) and utilizing a provision format that includes a portable document format (which Karaev teaches in that his system has the ability to convert files to PDF). The applicant is reminded that

Art Unit: 2152

although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

28. It is further noted that if the claim included user specification of the format, Karaev also teaches this as his system outputs files in a format specific to recipients as required by an information provider. Again see column 1, lines 38-47 and column 4, lines 55-63.

29. In addition, the applicant has argued that claims rejected under 35 U.S.C. 102 and 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

Conclusion

30. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2152

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

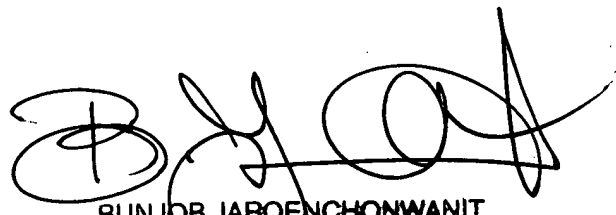
The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor Lesniewski
Patent Examiner
Group Art Unit 2152



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER